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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,674	11/21/2003	Hiroyuki Sakuyama	245673US2	9064
22850	7590	12/01/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER DANG, DUY M	
			ART UNIT	PAPER NUMBER
			2624	
			NOTIFICATION DATE	DELIVERY MODE
			12/01/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/717,674	SAKUYAMA ET AL.	
	Examiner	Art Unit	
	Duy M. Dang	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/25/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7, 18 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 18 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/8/08 & 6/13/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/25/08 has been entered.
2. Applicant's amendment filed on 8/25/08 has been entered and made of record and claims 1, 7, 18 and 24 are currently pending.

Response to Arguments

3. Applicant's arguments (referred as Argument hereinafter) filed 8/25/08 have been fully considered.

It is noted that the Argument is based on the ground that Nishikawa fails to teach or suggest "information included in a comment marker corresponding to said compressed and coded data" as additional amended to claims, the examiner disagree and would like to offer the following remarks:

(i)Applicant is reminded that the examiner is entitled to give the broadest reasonable interpretation to the language of the claims. So the examiner considers coding mode/type or picture type (information with regard to I/B/P picture and coding type used to code these type of picture which is either intra-frame coding or inter-frame coding) to be Applicant's claimed "comment marker" within the broad meaning of the term. The examiner is not limited to applicant's definition which is not specifically set forth in the claims. In re Tanaka et al., 193 USPQ, (CCPA) 1977. For example, item 230 of figures 8 and 10 and described at col. 20, lines

24-26, and item 225 of figure 6 and described at col. 15 lines 44-46 correspond to the so called marker.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishikawa et al., referred as Nishikawa hereinafter (USPN 6,246,438.)

The advanced statements as set forth in paragraph 3 above are incorporated hereinafter.

Regarding claim 1, Nishikawa teaches an apparatus for coding and decoding (see figures 1 and 5-6 each comprises coder and decoder depicted at 40 and 50 respectively), comprising: a decoding unit which decodes compressed and coded data to restore original image data (decoder 50 of figures 1 and 5-6. Also, see analyzer depicted at 310 in each of figures 1 and 5-6 functions as the so called “decoding unit” according to figures 13-14 and column 10 lines 45-62); a storing unit which stores additional information other than the image data in memory (see

memory depicted at 315 and 328 of figure 13); and a coding unit which encodes at least a portion of the additional information stored in said memory as information additional to the image data when performing second-time encoding of the image data decoded by said decoding unit (see re-encoding apparatus 30 of figures 1 and 5-6 comprising synthesizer 320 which functions as a second-time encoding and generates coded data 240); and an additional information extracting unit which extracts the additional information from the compressed and coded data when the compressed and coded data is decoded (see extractor/estimator depicted at 350 of figure 6; separator depicted at 340 of figure 5; col. 17 lines 25-26: extracting data corresponding to the coded data”; col. 26 lines 3-4: “supplies...information 233 which is obtained in the course of the decoding”; col. 30 lines 23-25: “analyzer 310 extracts from the first image coded data 220 the quantization parameters”), and said storing unit stores the additional information extracted by said additional information extracting unit in said memory (see memory 315 and 328 of figure 13. Also refer to bus connection, arrow lines which can refer to memory to carry extracted information to synthesizer 320 from, for example, extractor 350 (figure 6) and/or separator 340 (figure 5)).

Regarding claim 7, Nishikawa further teaches a selection unit which selects whether to encode the additional information when said coding unit performs the second-time encoding (see searcher 329 and subtractor 330 of figure 13. Each or both refer to selection unit. Also see col. 29 lines 44-54).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2624

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa.

The advanced statements with regard to Nishikawa as applied to claims 1 and 7 above are incorporated herein. It is noted that claims 18 and 24 recite a computer readable record medium having a program embodied therein for carrying out the claimed invention as called for in apparatus claims 1 and 7. While Nishikawa discloses coder and decoder as pointed out in the 102 rejection above, Nishikawa does not explicitly teach the use of such medium having a program embodied therein. However, it is well known in the art (Official Notice taken in the previous Office action dated 10/18/07) to use such medium having a program embodied therein for coding and decoding because program or software is simple, cheap, and easier to modify and/or tailor. It is noted that Applicant did not traverse or argue with regard to examiner's taken Official Notice. Therefore, Applicant's failure to adequately traverse the Examiner's taking of Official Notice in the last office action is taken as an admission of the fact(s) noticed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use such medium having a program embodied therein in combination with Nishikawa for that reasons.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M. Dang whose telephone number is 571-272-7389. The examiner can normally be reached on Monday to Friday from 6:00AM to 2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh M. Mehta can be reached on 571-272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dmd
11/08

/Duy M Dang/
Primary Examiner, Art Unit 2624